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TILLERY, RASHAWN N

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARCEL VAN OS, FREDDY ALLEN ANZURES, SCOTT FORSTALL, GREG CHRISTIE, and IMRAN CHAUDHRI

Appeal 2013-004862
Application 12/364,470
Technology Center 2100

Before JEAN R. HOMERE, DANIEL N. FISHMAN, and BETH Z. SHAW, *Administrative Patent Judges*.

SHAW, *Administrative Patent Judge*.

DECISION ON REMAND

The application on appeal is before the Board on remand from the U.S. Court of Appeals for the Federal Circuit. *In re Van Os*, Appeal 2015-1975 (Fed. Cir. Jan. 3, 2017) (Order).

BACKGROUND

In a Final Office Action mailed October 19, 2011, the Examiner finally rejected all pending claims as follows: the Examiner rejected claims 1–3, 5, 6, 8, 9, 11–25, and 31–37 under 35 U.S.C. § 103(a) as being unpatentable over Hawkins (US 7,231,229 B1; iss. June 12, 2007), Gillespie (US 2002/0191029 A1; publ. Dec. 19, 2002), and Krishnan (US 6,278,454 B1; iss. Aug. 21, 2001) (Final Act. 2–12); and the Examiner rejected claims

38–41 under 35 U.S.C. § 103(a) as being unpatentable over Hawkins and Gillespie. Final Act. 12–16.

Appellants appealed to the Board pursuant to 37 C.F.R. § 41.31(a), requesting review of all grounds of rejection. We entered a final Decision (mailed May 21, 2015) ("Decision") reversing the rejection of claims 1–3, 5, 6, 8, 9, 11–25, and 31–37, and affirming the rejection of claims 38–41. *Ex parte Van Os,* Appeal 2013-004862. Appellants appealed to the Federal Circuit pursuant to 35 U.S.C. §§ 141 and 142, requesting reversal of the Board's decision to affirm the rejection of claims 38–41. The Federal Circuit vacated and remanded the case, and the appeal of claims 38–41 is now before the Board for further consideration consistent with the Federal Circuit's remand.

We reverse the Examiner's Decision rejecting claims 38–41, and enter a new ground of rejection.

ANALYSIS

In our prior Decision, we concluded the Examiner did not err in finding one skilled in the art would have recognized the combination of Hawkins and Gillespie teaches or suggests the disputed limitation of claim 38. Dec. 7. We quoted the Examiner, who concluded:

> [i]t would have been obvious to one of ordinary skill in the art at the time that the invention was made to combine the teachings of Hawkins of initiating a mode for reconfiguring the positions of icons displayed on a touch-sensitive display by dragging the icons to a new position with the teachings of Gillespie of visually indicating to a user on a display when a predefined user interface reconfiguration mode has been entered into by the user by sustaining a touch on the user interface. One of ordinary skill in the art would have recognized that Gillespie's technique of entering a

> user interface reconfiguration mode in response to a user sustaining a touch in proximity to an icon displayed on the touchscreen would be an intuitive way for users of Hawkins' device to enter into the editing mode in which they could rearrange the icons corresponding to applications on the interface.

Id.

In its opinion, the Federal Circuit stated that neither the Board nor the Examiner "provided any reasoning or analysis to support finding a motivation to add Gillespie's disclosure to Hawkins beyond stating it would have been an 'intuitive way' to initiate Hawkins' editing mode." *In re Van Os*, Appeal 2015-1975 (Fed. Cir. Jan. 3, 2017) (Order at 5). The Federal Circuit stated that the Board "did not explain why modifying Hawkins with the specific disclosure in Gillespie would have been 'intuitive' or otherwise identify a motivation to combine." *Id.*

In light of the Federal Circuit's opinion, we do not sustain the Examiner's rejection of claims 38–41.

NEW GROUND OF REJECTION

37 C.F.R. § 41.50(b)

We make the following new ground of rejection using our authority under 37 C.F.R. § 41.50(b).

Claim 38 is rejected under 35 U.S.C. § 103(a) as unpatentable over Hawkins and Gillespie.

We adopt as our own the findings set forth by the Examiner in the Grounds of Rejection concerning the teachings of Gillespie and Hawkins of the steps of claim 38. Final Act. 12–14.

An explicit teaching, suggestion, or motivation in the references is not

necessary to support a conclusion of obviousness. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 415–16 (2007); *In re Ethicon,* Appeal 2015-1696 (Fed. Cir. Jan. 3, 2017) (Order). The Supreme Court has instructed that "a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions" (*KSR*, 550 U.S. at 417), and apply "an expansive and flexible approach" to obviousness (*id.* at 415).

Hawkins teaches the limitations of claim 38, including interpreting a user input "as an input initiating an interface reconfiguration mode," (Hawkins, Fig. 13, 17:25–63 ("Screen 1300 may be activated, *for example,* by selecting an 'Edit Favorites Pages' command from an onscreen menu") (emphasis added); 13:54–56, Fig. 7, Fig. 13), but Hawkins does not explicitly teach a "second, longer, user touch." Gillespie, entitled "Touch Screen with User Interface Enhancement," teaches a second, longer user touch. In particular, Gillespie teaches icons being "touched in a special way instead of by an overall touch screen activation state." Gillespie ¶ 71. Gillespie explicitly teaches "holding the finger steady over an icon for a given duration," which triggers an action. *Id.*

One of ordinary skill in the art would have been motivated to combine Hawkins and Gillespie to have Hawkins' user interface icon reconfiguration mode (e.g., its "Edit Favorites" functionality) being initiated by a longer user touch because Gillespie, directed to user interface enhancement, also, like Hawkins, explicitly teaches moving and rearranging user interface icons ("[e]xisting icons could also be moved or rearranged") (Gillespie ¶ 61). Therefore, it would have been obvious to the ordinarily-skilled artisan at the

time of the invention to combine Hawkins's disclosure of an interface reconfiguration mode (Hawkins 17:44-54) with Gillespie's teachings of a user touch of a longer duration (*see* Gillespie ¶ 71) because Gillespie is also directed to user icons and a user interface reconfiguration process (*see id.* ¶ 61). Because both references are directed to enhancing features of user interfaces, the ordinarily-skilled artisan would have reasonably used Gillespie's longer touch for an icon, even if Hawkins does not explicitly teach a second, longer touch to activate its user reconfiguration mode. *See* Hawkins, 1:24–26; Gillespie ¶ 58. Moreover, such a combination is an obvious predictable variation of known elements. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR*, 550 U.S. at 416. "If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability." *Id.* at 417. The use of Gillespie's second, longer touch is a simple substitution for Hawkins's teaching of a user input. We note that it was well known to those of skill in the art to enter an edit mode, for example to change a time setting of a digital watch, by using a well-known sustained hold on a button/input of a digital watch. The ordinarily-skilled artisan, being "a person of ordinary creativity, not an automaton," would be able to fit the teachings of Hawkins and Gillespie together like pieces of a puzzle to predictably result in an interface wherein icons are reconfigured with a user's input of a longer touch. *Id.* at 420–21. Because Appellants have not demonstrated that the proposed combination would have been "uniquely challenging or difficult for one of ordinary skill in the art," the proposed modification would have been well within the purview of

the ordinarily skilled artisan. *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418).

We leave the patentability determination of claims 39–41 to the Examiner. *See Manual of Patent Examining Procedure* § 1213.02 (9th ed. Rev. 07. 2015, Nov. 2015).

DECISION

We reverse the rejection of claims 38–41.

We enter a new ground of rejection of claim 38 pursuant to 37 C.F.R. § 41.50(b) (2010). This section provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

TIME PERIOD

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner . . . .
>
> (2) *Request rehearing.* Request that the proceeding be reheard under §41.52 by the Board upon the same Record . . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED; 37 C.F.R. 41.50(b)